REMARKS

In the Office Action[1], the Examiner took the following actions:

objected to claims 15 and 16;

rejected claims 1, 9, 17, and 25 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement;

rejected claims 7, 8, 15, 16, 23, and 24 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite;

rejected claims 1-5, 9-13, and 17-21 under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent Publication 2002/0059127 to Brown et al. ("Brown") in view of U.S. Patent No. 7,016,870 to Jones et al. ("Jones");

rejected claims 7, 8, 15, 16, and 23-25 under 35 U.S.C. § 103(a) as allegedly obvious over Brown and Jones in view of U.S. Patent Publication 2005/0262014 to Fickes ("Fickes")

rejected claim 27 under 35 U.S.C. § 103(a) as allegedly obvious over Brown, Jones, and Fickes in view of U.S. Patent Publication 2004/0158479 to Adhikari ("Adhikari"); and

rejected claim 28 under 35 U.S.C. § 103(a) as allegedly obvious over Brown, Jones, Fickes and Adhikari, in view of Official Notice.

Claims 1-5, 7-13, 15-21, 23-25, 27, and 28 are pending in this application. Claims 7, 8, 15, 16, 23, and 24 are amended. Applicant submits no new matter is added by this Amendment.

[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Applicant respectfully traverses the objection to claims 15 and 16, Applicant has amended these claims to overcome the objection. Accordingly, it is requested that the objection be withdrawn.

Applicant respectfully traverses the rejection of claims 1, 9, 17, and 25 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Applicant's specification states "[t]he follow[ing] terms used in the above-description are defined below: . . . Book value: Asset component which contains the amortized acquisition value and the results of all valuations performed (e.g. valuation in the subsection, valuation in the foreign exchange)." Page 22 line 10 - Page 23 line 3. Another portion of the specification states "a book value for each object is automatically ascertained from an accounting system and a market value for each object is also automatically ascertained (emphasis added)." Page 4 lines 22-23. The specification also states "[a] program can automatically query the book value and/or the acquisition value of the objects contained in the system from the database in the accounting system at settable intervals of time" (emphasis added). Page 7 lines 9-11.

Applicant respectfully asserts that the term "determining a book value" is enabled at least because one of ordinary skill in the art would be able to ascertain that a "book value" can be determined at least by a "query . . . [of] objects contained in the . . . database in the accounting system" as described in the specification.

Furthermore, and notwithstanding the above discussion, one of ordinary skill in the art would be able to "determine a book value" because the "book value" is defined as an "asset component" which contains the "amortized acquisition value and results of

all valuations performed." Amortization is not beyond the skill of one of ordinary skill in the art and thus, the term "determining a book value" is enabled. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1, 9, 17, and 25 under 35 U.S.C. § 112, first paragraph.

Applicant respectfully traverses the rejection of claims 7, 8, 15, 16, 23, and 24 under 35 U.S.C. § 112, second paragraph. These claims have been amended to recite "the calculated impairment price." Accordingly, these claims clearly find antecedent basis in the independent claim from which each of these claims depends.

Applicant respectfully traverses the rejections of the claims under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to these claims. For example, Brown does not teach or suggest each and every feature of claim 1 as asserted by the Final Office Action.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See id. "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P.§ 2154. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior

art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. §2141.02(I), internal citations omitted (emphasis in original).

"[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Claim 1 recites, in part, "automatically forming an intermediate variable from the book value and the market value." Brown does not disclose or suggest at least this feature of claim 1.

The Office Action states that it interprets the "market value" in Paragraph [0033] of Brown as corresponding to the claimed "market value." Further, the Office Action states that Brown's disclosed "current index value [is] analogous to Applicant's intermediate variable." Office Action at page 5. This interpretation, however, is inconsistent with the Brown disclosure.

For example, Brown discloses that "[t]o harvest tax losses, it is necessary initially to determine the present market value of each security in the modeled index to determine current index values step 22." Brown paragraph [0033]. In other words,

Brown states that the "market value of each security" is determined in a method step called "determine current index values." But, if a "determine current index value" step determines a "present market value," then a "current index value" **is** a "market value." Thus, even assuming that the "market value" in Brown could constitute the claimed "market value," which Applicant does not concede, the Office Action's allegation that the "current index value" can constitute the claimed "intermediate variable" is incorrect.

Thus, Brown's disclosure of a "current index value" cannot constitute the claimed "intermediate variable" because the "current index value," which the Office Action alleges as analogous to the claimed "intermediate variable, **is not** "form[ed] from the book value and the market value" as claimed in claim 1. Simply put, in Brown, the current index value is also the market value and therefore is not "intermediate" to the claimed "book value" and "market value."

In sum, Brown cannot disclose the claimed "intermediate variable," as the Office Action suggests, because Brown discloses that the "current index value" and the "market value" are the same value. No other portions of Brown, or even the disclosure as a whole, can reasonably be said to disclose or suggest the claimed "intermediate variable." As such, Applicant respectfully requests that the Examiner withdraw the rejection of claim 1 under 35 U.S.C. § 103(a).

Jones does not remedy the deficiencies of Brown. For example, Jones is directed to a financial advisory system which produces forecasts for financial advisory services. Jones abstract. Jones, however, fails to disclose or suggest anything that could reasonably be interpreted to constitute the claimed "forming an intermediate

variable from the book value and the market value." Moreover, the combination of Brown and Jones fails to reasonably suggest the claimed "forming an intermediate variable from the book value and the market value" at least because there is no disclosure in Brown or Jones that teaches or suggests what purpose an "intermediate variable" which is "form[ed] from the book value and the market value" would fulfill or how such an "intermediate variable" could be otherwise useful to the combination of Brown and Jones.

Independent claims 9, 17, and 25 contain features similar to those discussed in connection with claim 1. None of Fickes, Adhikari, or Official Notice remedy the deficiencies of Brown and Jones as outlined above. Applicant therefore asserts that these claims are allowable for at least similar reasons as claim 1. In instances where the Examiner has relied on Official Notice, Applicant requests the Examiner provide evidence of each and every assertion made in the Office Action.

The dependent claims are allowable for at least the same reasons as the independent claims from which these dependent claims depend. Applicant respectfully requests the Examiner withdraw the rejections of the claims under 35 U.S.C. 103 and allow the claims.

CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 24, 2009

By: _____
Travis R. Banta
Reg. No. 60,498